

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Paradis et al.

Application No.: **10/602,459**

Group No.: 1771

Filed: June 23, 2003

Examiner: **Matthew D. Matzek**

For: **FIBER AND YARN BLENDS, METHODS OF PRODUCTION AND APPLICATIONS THEREOF**

MAIL STOP APPEAL BRIEF – PATENTS
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AMENDED APPELLANT'S BRIEF UNDER 37 CFR § 41.37

This brief follows the appellant's Notice of Appeal filed in this case on August 13, 2007. The Appeal Brief was originally filed on, October 15, 2007, but according to the Notice of Non-compliant Appeal Brief mailed by the USPTO on November 5, 2007, Section III did not identify the claims on appeal. This Amended Appellant's Brief identifies the claims on appeal.

This brief contains the following items under the headings in the order here indicated:

APPELLANTS BRIEF UNDER 37 CFR § 41.37

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REAL PARTY IN INTEREST

The real party in interest is the assignee, Honeywell International Inc. (see Reel/Frame No. 014336/0277, Recorded on February 12, 2004)

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences in this matter known to appellant.

STATUS OF THE CLAIMS

There are 27 claims in this case.

Claims 27-56 and 58-59 were cancelled in Response to the Restriction Requirement entered on April 18, 2005 by Examiner's Amendment.

Claims 1-26 and 57 are pending.

Claims 1-26 and 57 are on appeal.

STATUS OF AMENDMENTS

There have been no amendments filed subsequent to the advisory action received on July 25, 2007 in this matter. This advisory action was in response to a Response After Final filed on July 6, 2007.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed subject matter is directed to a fiber material that includes: a) a first base fiber component comprising a first denier and a first luster component (page 4, lines 1-8 and 22-29, page 5 in its entirety, and page 6, lines 1-5); b) a second base fiber component comprising a second denier and a second luster component, wherein the first denier and the second denier are different and wherein the first luster component and the second luster component are different (page 4, lines 1-8 and 22-29, page 5 in its entirety, and page 6, lines 1-5); and c) a plurality of binder fibers (page 6, lines 6-14).

In addition, the claimed subject matter is directed to methods that teach that a fiber material may be produced that includes: a) providing a first base fiber component comprising a first denier and a first luster component (page 4, lines 1-8 and 22-29, page 5 in its entirety, and page 6, lines 1-5); b) providing a second base fiber component comprising a second denier and a second luster component, wherein the first denier and the second denier are different and wherein the first luster component and the second luster component are different (page 4, lines 1-8 and 22-29, page 5 in its entirety, and page 6, lines 1-5); c) providing a plurality of binder fibers (page 6, lines 6-14); and d) blending the first base fiber, the second base fiber and at least some of the plurality of binder fibers to form the fiber material (page 9, lines 9-29).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-26 and 57 are rejected under 35 USC 103(a) as being unpatentable over Cobb et al. (US 3608297) in view of Miller et al. (US 2003/0165656).

ARGUMENT

ISSUE NO. 1 - §103 (A) REJECTION OF CLAIMS 1-26 and 57

Claim 1 recites:

“A fiber material, comprising:

a first base fiber component comprising a first denier and a first luster component;

a second base fiber component comprising a second denier and a second luster component, wherein the first denier and the second denier are different and wherein the first luster component and the second luster component are different; and

a plurality of binder fibers.”

As recited in the claim, there are three components in the fiber material - two base fiber components – each having a denier and a luster component, whereby the individual deniers and luster components are different, and a plurality of binder fibers.

The Miller publication teaches a conventional carpet fiber and a binder material, wherein the yarn is subject to singeing to remove protruding fiber ends, and subjected to heat sufficient to melt the binder fiber. The Miller publication – as the Examiner admits – is silent as to the use of mixed denier and different luster components.

The Cobb reference, on the other hand, teaches a yarn with a combination of delustred filaments, wherein the yarn is designed to provide an improvement in appearance by giving anti-soiling effects. In the Examples Section of the Cobb reference, Cobb points out that when comparing a carpet contemplated by Cobb with an conventional carpet, “the difference in soiling by visual observation was apparent after 30 days”. As a matter of fact, the Examples are focused entirely on

pointing out that the yarns and carpets described by Cobb resist soiling over conventional yarns and carpets.

The Federal Circuit has stated that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” (See *In re Geiger*, 815 F.2d 686, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)). The Patent Office applied the same standard at the time this case was proceeding through the USPTO. “When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper...Absent such reasons or incentives, the teachings of the references are not combinable.” (See *Ex parte Skinner*, 2 USPQ2d 1788, 1790 (BPAI 1986)). The Federal Circuit crystallizes this concept by the following ruling:

“It is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” (See *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Close adherence to this standard is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher.” (See *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)(citing *W. L. Gore & Assocs. v. Garlock, inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). In addition, a general relationship between fields of the prior art patents to be combined is insufficient to establish the suggestion or motivation.

(See *Interactive Techs., Inc. v. Pittway Corp.*, Civ. App. No.: 98-1464, slip op. at 13 (Fed. Cir. June 1, 1999)(unpublished), cert. denied, 528 U.S. 1046 (1999). As stated by the Federal Circuit:

“The genius of invention is often a combination of known elements which in hindsight seems preordained. To prevent hindsight invalidation of patent claims, the law requires some “teaching, suggestion or reason” to combine cited references... When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously.” (*McGinley v. Franklin Sports Inc.*, 262 F.3d 1339, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)(citing *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997)).

Failure of the Examiner to provide the necessary suggestion or motivation will create a presumption that the combination of references selected by the Examiner to support the obviousness rejection was based on hindsight. (Irah H. Donner, *Patent Prosecution, Practice & Procedure Before the U.S. Patent Office*, Third Edition) In this case, the Examiner fails to point out how one of ordinary skill in the art would read Cobb and determine that the yarns or carpet fibers need to be improved, especially given the fact that the crux of the invention in Cobb is improving yarn's and carpet's anti-soiling effects.

The Examiner states in the Final Office Action that Miller overcomes the disadvantages of using either staple fibers or continuous filaments in the production of carpets by using binder fibers; however, the Examiner doesn't explain why someone reading Cobb would think to include binder fibers, given that Cobb solves the problem of aesthetics and soil-ability with other means. It is improper to say that Cobb would include binder fibers had Cobb known about them through the Miller reference, because Cobb doesn't state that there are additional needs that should be met by something like a binder fiber; therefore, there is no motivation to combine the references. The Examiner is using the template approach to combine these references based on hindsight. There

needs to be some motivation in the references to combine those references, not a puzzle that is assembled by the Examiner because of some perceived need in the references.

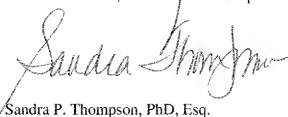
The Examiner then states that the motivation to combine comes from Miller and not Cobb, but again, this doesn't help the Examiner's case for the combination. The Miller publication teaches a conventional carpet fiber and a binder material, wherein the yarn is subject to singeing to remove protruding fiber ends, and subjected to heat sufficient to melt the binder fiber. The Miller publication – as the Examiner admits – is silent as to the use of mixed denier and different luster components; yet the Examiner continues to contend that the Miller reference is the primary reference and one would naturally read Miller and arrive at the conclusion that the reference should be combined with Cobb; however, that contention does not stand up to scrutiny. The Examiner has not adequately explained why one of ordinary skill in the art would read Miller and even think to combine it with Cobb to get mixed denier and different luster components at the same time, given that there is no need in Miller to have mixed denier and different luster components at the same time based on that disclosure. There is just no motivation.

Based on this argument, claim 1 is allowable as being patentable over the Cobb reference in view of the Miller publication. In addition, claims 2-26 and 57 are also allowable as being patentable over the Cobb reference in view of the Miller publication by virtue of their dependency on claim 1.

Respectfully submitted,
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APPENDIX OF PENDING CLAIMS

1. (Original) A fiber material, comprising:

a first base fiber component comprising a first denier and a first luster component;

a second base fiber component comprising a second denier and a second luster component, wherein the first denier and the second denier are different and wherein the first luster component and the second luster component are different; and

a plurality of binder fibers.
2. (Original) The fiber material of claim 1, wherein at least some of the binder fibers comprises a synthetic material.
3. (Original) The fiber material of claim 2, wherein the synthetic material comprises a polyamide-based compound.
4. (Original) The fiber material of claim 3, wherein the polyamide-based compound comprises nylon-6.
5. (Original) The fiber material of claim 3, wherein the polyamide-based compound comprises nylon-6,6.
6. (Original) The fiber material of claim 3, wherein the polyamide-based compound comprises nylon-12.
7. (Previously Presented) The fiber material of claim 1, wherein the fiber material comprises less than about 2.5 weight percent binder fibers.
8. (Previously Presented) The fiber material of claim 7, wherein the fiber material comprises less than about 2 weight percent binder fibers.

9. (Previously Presented) The fiber material of claim 8, wherein the fiber material comprises less than about 1.5 weight percent binder fibers.
10. (Previously Presented) The fiber material of claim 9, wherein the fiber material comprises less than about 1 weight percent binder fibers.
11. (Original) The fiber material of claim 1, wherein the first luster component is less than about .45% TiO_2 .
12. (Original) The fiber material of claim 11, wherein the first luster component is less than about .25% TiO_2 .
13. (Original) The fiber material of claim 12, wherein the first luster component is less than about .15% TiO_2 .
14. (Original) The fiber material of claim 13, wherein the first luster component is less than about .1 % TiO_2 .
15. (Original) The fiber material of claim 1, wherein the second luster component is less than about .45% TiO_2 .
16. (Original) The fiber material of claim 15, wherein the second luster component is less than about .25% TiO_2 .
17. (Original) The fiber material of claim 16, wherein the second luster component is less than about .15% TiO_2 .
18. (Original) The fiber material of claim 17, wherein the second luster component is less than about .1 % TiO_2 .
19. (Original) The fiber material of claim 1, wherein the first denier is from about 6 to about 12.

- 20. (Original) The fiber material of claim 1, wherein the second denier is from about 6 to about 12.
- 21. (Original) The fiber material of claim 19, wherein the first denier is less than about 12.
- 22. (Original) The fiber material of claim 21, wherein the first denier is less than about 7.
- 23. (Original) The fiber material of claim 22, wherein the first denier is 6.5.
- 24. (Original) The fiber material of claim 20, wherein the second denier is less than about 12.
- 25. (Original) The fiber material of claim 24, wherein the second denier is 10.
- 26. (Original) The fiber material of claim 24, wherein the second denier is less than about 7.

Claims 27-56: Canceled.

- 57. (Original) A yarn product comprising the fiber material of claim 1.

Claims 58-59: Canceled.

EVIDENCE APPENDIX

There is no additional evidence submitted during this Appeal brief.

RELATED APPEALS AND INTERFERENCES APPENDIX

There are no other appeals or interferences in this matter known to appellant, and therefore, there are no additional attachments under this heading.